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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,554	06/19/2006	Mineyuki Kubota	292333US0PCT	9827
22850 7590 09/24/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER BROOKS, CLINTON A				
ART UNIT		PAPER NUMBER		
1621				
NOTIFICATION DATE		DELIVERY MODE		
09/24/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

### Office Action Summary

**Application No.**

10/583,554

**Applicant(s)**

KUBOTA ET AL.

**Examiner**

CLINTON BROOKS

**Art Unit**

1621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

This action is **FINAL**.

### ***Status of Claims***

In the response received July 13, 2009, Applicants amended claim 1-3, 5, 6, and 12. Claims 4 depends from amended claim 2. Claims 7-11 stand withdrawn, and Claims 13 and 14 are added as new claims.

### ***Non-Statutory Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

***Provisional Double Patenting***

**Claims 1**, stands provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 2 of copending Application No. 10519934 (“the ‘934 application”). Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the instant application are anticipated or obvious variants of the ‘042. Specifically, the ‘934 application teaches an anthracene derivative wherein Ar and Ar’ is selected from a group of ring systems having substituted aromatic hydrocarbon ring group having 10 to 20 ring carbons (claim 1). Further the ‘934 application teaches that the substituents on the anthracene ring can be represented by a substituted or unsubstituted alkyl group (claim 1 of ‘934), and claim 2 recites to an anthracene derivative as stated in claim 1 of the ‘934 application wherein the anthracene derivative is a light emitting material for organic luminescence.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Applicants Arguments and Amendments:***

In view of Applicants’ amendment, the objection to claim 1 is withdrawn.

With respect to holding the provisional double patent rejection in abeyance, this request is acknowledged. However, Applicant is reminded that the Office cannot hold a rejection in abeyance and “[i]n order to be entitled to reconsideration or further examination, the applicant

or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action." Because Applicant has failed to present an amendment or argument that overcomes the present rejection, the provisional rejection is maintained. Any future submissions that fail to address the merits of the non-statutory double patenting rejection might be deemed to be non-responsive.

In view of Applicants' amendment, the 35 USC § 102 to JP-2001-097897 is withdrawn.

*New Rejections Necessitated By Amendment*

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

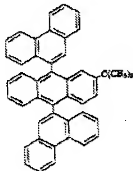
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 1-6, 12-13** are rejected under 35 U.S.C. 102(b) as being anticipated by JP-11323323 ("the '323 publication", published November 26, 1999). A machine translation is being provided, the abstract of the '323 publication was made of record in the IDS dated June 19, 2006.

The '323 publication teaches compounds having the following structure:

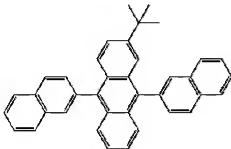
{0041}  
{化13}



**Claims 1-5, 12-13** are rejected under 35 U.S.C. 102(a, e) as being anticipated by US2003/0068524 ("the '524 publication", made of record JP-11323323 ("the '323 publication", published November 26, 1999). A machine translation is being provided, the abstract of the '323 publication was made of record in the IDS dated June 19, 2006.

The '323 publication teaches at least the following specie:

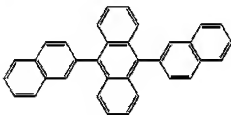
[0064] b) tertiary butyl AND (TBADN)



Further, these compounds have utility in organic light emitting devices (title). Further, the species above is preferred. Specifically, the '524 publication teaches:

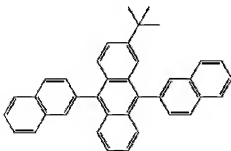
[0061] Preferred host materials for the blue luminescent layer of this invention include:

[0062] a) ADN



[0063] ;or

[0064] b) tertiary butyl AND (TBADN)



Thus, the '323 publication teaches that the t-butyl species is one of two preferred compounds.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

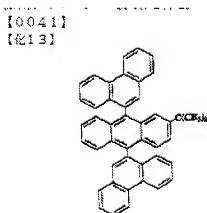
This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(e) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claim 1-6, 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-11323323 ("the '323 publication", published November 26, 1999) in view of US2003/0068524



("the '524 publication", made of record JP-11323323 ("the '323 publication", published November 26, 1999).

The '323 publications teaches as disclosed above and which is incorporated by reference herein. For example the '323 publication teaches the following specie which contains a 9-phenanthryl group:



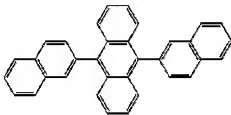
Further, the '323 publication teaches that these compounds have utility in organic light emitting devices (title).

The '323 publication fails to teach a specific compound as recited in claim 14.

The '524 publication teaches as disclosed above, and those teachings are incorporated by reference herein. For example the '524 publication teaches that the compound in paragraph [0064] is one of two preferred compounds.

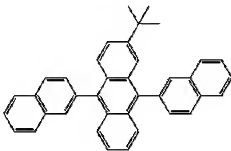
[0061] Preferred host materials for the blue luminescent layer of this invention include:

[0062] a) ADN

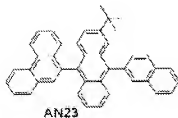


[0063] ;or

[0064] b) tertiary butyl AND (TBADN)



One of the species of claim 14 is shown below for reference:



It would have been prima facie obvious to one having ordinary skill in the art at the time the invention was made to substitute the naphthyl arm of the specie taught by the '524 publication with one of the 9-phenylantryl arms of the specie taught by the '323 publication to

arrive at the specie AN23 recited in claim 14 because the '524 publication teaches that the naphthyl containing structure is preferred. One would expect success in the substitution because the art teaches that these molecules are used for the same purpose.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CLINTON BROOKS whose telephone number is (571)270-7682. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DANIEL SULLIVAN can be reached on (571)272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cab

/Daniel M Sullivan/

Supervisory Patent Examiner, Art Unit 1621